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UNITED STATES DISTRICT COURT  
NORTHERN DISTRICT OF CALIFORNIA

IMPINJ, INC.,

Plaintiff,

v.

NXP USA, INC.,

Defendant.

Case No. 4:19-cv-03161-YGR

**STIPULATION TO DISMISS  
COUNTERCLAIMS AND AFFIRMATIVE  
DEFENSES**

Pursuant to Federal Rule of Civil Procedure 41(a) and (c), the parties offer this stipulation to simplify the case in light of the fact that only four patents remain at issue. Specifically, only the '302 and '631 Patents (which are not stayed), and the '597 and '266 Patents (which currently are stayed until September 1, 2021), remain in dispute in this action.

### **I. Background**

On June 6, 2019, Plaintiff Impinj, Inc. filed a Complaint (Dkt. 1) accusing Defendant NXP, USA, Inc. ("NXP") of infringing 26 patents. NXP's Answer (Dkt. 24) asserted counterclaims, *inter alia*, for Fraudulent Concealment, Breach of Contract, and Promissory Estoppel. These counterclaims relate to 13 of the 26 patents (the "Gen2 V2 Patents"), none of which are still being asserted in this action. NXP also asserted a number of affirmative defenses relating to the Gen2 V2 Patents.

Through Impinj's First and Second Amended Complaint (Dkt. Nos. 59 and 71), as well as a Court-ordered reduction of asserted claims (Dkt. No. 39), this case has now been narrowed down to four patents: U.S. Patent Nos. 9,495,631 ("the '631 Patent"); 9,633,302 ("the '302 Patent"); 8,115,597 ("the '597 Patent"); and 10,002,266 ("the '266 Patent").

On March 30, 2020, the Court granted the parties' Stipulated Request to Stay Proceedings (Dkt. No. 63) on the six patents then remaining in the case at that time, pending *inter partes* review proceedings ("IPR") in the Patent and Trademark Office ("PTAB"). In relevant part, the PTAB instituted IPR proceedings against U.S. Patent Nos. 9,471,816 ("the '816 Patent") and 8,344,857 ("the '857 Patent"), and denied institution on the '631, '302, '597 and '266 Patents. Impinj has dismissed the '816 and '857 Patents from this lawsuit. Dkt. 71, 75. On September 24, 2020, the Court lifted the stay as to the '631 and '302 Patents, but maintained the stay over the '597 and '266 Patents because they are similar in subject matter to the '816 and '857 Patents in the instituted IPR proceedings. Dkt. 65.

The Court set a briefing schedule for claim construction as to the '631 and '302 Patents only, with a claim construction hearing that originally was set for March 24, 2021, but then was continued until July 23, 2021. Dkt. Nos. 70 and 82. As for the stayed '597 and '266 Patents, the

1 Court indicated that once the IPR proceedings were concluded on the similar '816 and '857 Patents  
 2 – which will occur no later than September 1, 2021 – it would be willing to approve an accelerated  
 3 schedule to return the '597 and '266 Patents to the case, which will include claim construction  
 4 briefing and an additional claim construction hearing. Dkt. 70. The parties believe that they also  
 5 will be able to agree to a schedule that allows all four patents to be tried together, without significant  
 6 disruption to the current timeline.

7 The parties now stipulate to dismiss the NXP affirmative defenses and counterclaims that  
 8 do not relate to the four patents that remain in this case, *i.e.*, the '631, '302, '597 and '266 Patents.

## 9 II. Stipulation to Dismiss

10 In a good faith effort to continue to streamline this case and expeditiously resolve this  
 11 dispute, NXP hereby stipulates to the dismissal without prejudice of NXP's Thirteenth, Fourteenth,  
 12 and Fifteenth Counterclaims (for Fraudulent Concealment, Breach of Contract, and Promissory  
 13 Estoppel, respectively) as well as NXP's Third, Fourth, Fifth, Sixth, Seventh, and Eighth  
 14 Affirmative Defenses (for Royalty-Free License, RAND License, Unclean Hands, Equitable  
 15 Estoppel, Waiver/Implied Waiver, and Patent Misuse, respectively).

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 17 Respectfully submitted: July 8, 2021.

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1 Pursuant to Local Rule 5-1, the below filer attests that concurrence in the filing of this  
2 document has been obtained from the above Signatories.

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